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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/696,422	10/29/2003	Kazuhiko Kageyama	2803.68663	7118

7590 08/16/2004

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EXAMINER

WATKO, JULIE ANNE

ART UNIT	PAPER NUMBER
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2652

DATE MAILED: 08/16/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/696,422	Applicant(s) KAGEYAMA ET AL.	
	Examiner Julie Anne Watko	Art Unit 2652	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2-13 and 15-18 is/are pending in the application.
 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 2-13 and 15-18 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 October 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☒ Certified copies of the priority documents have been received in Application No. 09/814,079.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>10/29/2003</u> . | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Priority

1. Applicant has not complied with one or more conditions for receiving the benefit of an earlier filing date under 35 U.S.C. 120 as follows:

An application in which the benefits of an earlier application are desired must contain a specific reference to the prior application(s) in the first sentence of the specification or in an application data sheet (37 CFR 1.78(a)(2) and (a)(5)). The specific reference to any prior nonprovisional application must include the relationship (i.e., continuation, divisional, or continuation-in-part) between the applications except when the reference is to a prior application of a CPA assigned the same application number.

The Examiner suggests amending the first page of the specification to refer to the parent case, SN 09814079.

Drawings

2. New corrected drawings in compliance with 37 CFR 1.121(d) are required in this application because the proposed drawing correction filed October 29, 2003, has been approved. Applicant is advised to employ the services of a competent patent draftsman outside the Office, as the U.S. Patent and Trademark Office no longer prepares new drawings. The corrected drawings are required in reply to the Office action to avoid abandonment of the application. The requirement for corrected drawings will not be held in abeyance.

3. In Figs. 25A-D, the location of spindle 81 is inconsistent with its location in Figs. 20A-B. From the appearance of parts 83 and 93, it is clear that Figs. 25A-D are views of the apparatus from the far left side of Fig. 20B. Spindle 81 is consistently shown in the

other figures as closer to 911 than to 93. The location of the spindle 81 is relevant to the directions of motion of sheet loader 9 during loading and ejection, and to the directions of approach toward and separation from the recording medium.

Claim Objections

4. Claim 2 is objected to because of the following informalities: Claim 2 recites "said loading mechanism" in lines 2-3. No "loading mechanism" has been previously recited. The Examiner suggests --A storage device having a loading mechanism, which loads-- in line 1. Appropriate correction is required.

Claim Rejections - 35 USC § 112

5. Claims 2-13 and 15-18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

a. Claim 2 recites the limitation "a lifting mechanism for moving said lift plate vertically" in line 4. It is unclear whether the "lifting mechanism" refers to the constraining mechanism, the holding mechanism, or to some distinct part. Moreover, because this limitation appears in the preamble, it is unclear whether a "lifting mechanism" is part of the claimed device.

b. Claim 5 recites the limitation "inclined planes that are engaged with said pins when said holding mechanism is moved in the direction opposite to the direction of insertion of said storage medium, and that thus **separate** said spindle motor from said storage medium" in the last 3 lines (emphasis added). This limitation is misdescriptive of the specification, which shows that the spindle motor approaches the storage medium during insertion when the holding

mechanism moves in a direction opposite to the insertion direction at the completion of inserting. See page 26, line 24-page 27, line 21 of the specification. Furthermore, the limitation is inconsistent with claim 3, which recites "moving said holding mechanism in a direction opposite to a direction of insertion of said storage medium at the completion of inserting said storage medium into said body, and allowing said constraining mechanism to quickly move said lift plate **towards** said storage medium." in the last 4 lines (emphasis added).

c. Claim 6 recites the limitation "A storage device according to Claim 1" in line 1. Claim 1 has been cancelled. Furthermore, even if claim 6 were rewritten to depend from claim 2, the claim would fail to further limit claim 2.

d. Claims 7-9 and 17 recite the limitation "A storage device according to Claim 1" in line 1. Claim 1 has been cancelled.

e. All other claims are rejected as indefinite by virtue of their dependency from indefinite claims.

Allowable Subject Matter

6. Claims 2-4, 11 and 15-16 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

7. Regarding claims 5-10, 12-13 and 17-18: In the absence of a reasonably definite interpretation of a claim, it is improper to rely on speculative assumptions regarding the meaning of a claim and then base a rejection under 35 U.S.C. 103 on these assumptions (*In re Steele*, 305 F.2d 859, 134 USPQ 292 (CCPA 1962)). See MPEP 2143.03.

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Kato (JP 6-215467 A) shows a storage device comprising constraining mechanism 18 between lift plate 10A and chassis 15, further comprising a mechanism ("cartridge drawer device which is not illustrated", see ¶ 0018); however, the reference is silent regarding whether the mechanism loads a storage medium into a body of the storage device (see especially magazine 11 in Fig. 2).

9. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

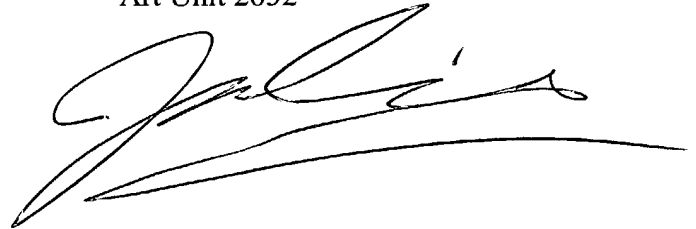
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Julie Anne Watko whose telephone number is (703) 305-7742. The examiner can normally be reached on Monday-Thursday, 9AM-5PM, Friday 9AM-7:30PM.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hoa T. Nguyen can be reached on (703) 305-9687. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Julie Anne Watko
Primary Examiner
Art Unit 2652

August 9, 2004
JAW

A handwritten signature in black ink, appearing to read 'Julie', with a long horizontal flourish extending to the right.